

REMARKS

This application has been carefully considered in view of the Office Action referenced above. Applicant respectfully traverses the rejections. The undersigned discussed this case with Examiner Bennett on March 26, 2004, and appreciates the Examiner's time and consideration of Applicant's position with respect to the current Final Office Action.

Regarding the rejection to claims 5, 9, 10, 11 and 17 based upon Harris in view of Shurtleff, Applicant respectfully traverses on the following grounds. The Shurtleff reference is asserted to be essentially identical to the claims except for the magnetic base which is shown in Harris. However, it is respectfully submitted that the claims distinguish over the Harris reference at least in that the gravitational pull directly on the needle in Applicant's claims causes the needle to indicate the current grade angle (i.e., the needle points down). This is accomplished, in part, by recognition that the scale can be placed at the bottom of the measurement device so that gravity naturally pulls on the needle to cause it to point at the proper grade angle. None of the cited art shows or suggests this.

Harris, on the other hand, requires either a counter-weighted needle or a needle with buoyancy to force the needle to point upward. There appears to be no recognition whatsoever in Harris or the other art of record of the paradigm of inversion of the scale and allowing the needle to point downward in order to achieve a simpler design. In Harris' device, gravity pulls the counterweight rather than the indicator needle. This is a much more complicated mechanism than that disclosed and claimed by Applicant. Applicant's structure is significantly simpler in that it relies upon the weight of a simple needle alone with its movement damped by the fluid in the compartment. Applicant's claimed device substitutes a single needle indicator for the three part structure (21, 22 and 58) used in Harris. This three part structure, moreover, obviously requires significant machining to produce. This results in a comparatively much higher cost and complexity than the simple stamped or otherwise formed needle structure of Applicant.

The claims call for the "indicator needle pivotally suspended so that gravitational forces acting on the needle cause" the functional pointing of the needle (or similar limitations). It is respectfully submitted, as stated above, that in Harris it is the force of gravity pulling on the weight 21 that controls the movement of the needle, thus failing to meet or suggest the claim limitation. Given the orientation of elements 13 and 90 of Harris, there is obviously no recognition that the needle should do anything other than point upward. Although Harris has a scale that extends around to the bottom, it is not clear that the bottom portion of the scale is useful, and even if it is, Harris' needle will still be forced to point up by virtue of the weighted bottom of the needle.

Thus, Applicant's invention is quite simple and less costly and complex to manufacture compared to the device of the Harris reference. It has been noted by the CAFC in *In re Oetiker* that "*Oetiker's invention is simple. Simplicity is not inimical to patentability.*" (*In Re Oetiker*, 977 F.2d 1443) Accordingly, this distinction of significant simplification cannot be dismissed or ignored, rather, it may be suggestive of patentability. Other case law also indicates that simplicity itself has been held to be an *indicia of non-obviousness*. Applicant respectfully requests that the examiner give due consideration to the facts that:

- a) There is no teaching or suggestion of orientation of the needle downward.
- b) There is no teaching or suggestion of allowing the weight of the pointing end of the needle to induce movement of the needle by the force of gravity.
- c) The simplification in design afforded by a) and b) results in a reduced number of parts, simplification of the needle structure and thus reduced cost.
- d) The fact that simplicity itself has been considered an *indicia of obviousness*.

Reconsideration and allowance is, thus, respectfully requested.

Regarding the rejection of claims 6-8, 12-16 and 18-22, based upon Harris, Shurtleff and Dougherty, Applicant also traverses this rejection on the following grounds.

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It is noted first of all that the effective date of the Dougherty reference is no earlier than Nov. 8, 2001. Applicant's application claims a priority date of a provisional application dated Feb. 27, 2001. This provisional application contains similar disclosure to that of the present non-provisional application. Accordingly, the Dougherty reference cannot be considered prior art to the present application. Thus, the rejection is fatally flawed. Reconsideration and allowance is respectfully requested.

In addition, it is noted that the Dougherty reference is involved with a totally different field than that of Applicant. Dougherty is related to a conduit bending device. One of ordinary skill in the art of design or use of slope measurement devices cannot be properly charged with knowledge of the conduit bending art. Thus, even if the Dougherty reference were properly prior art to the present invention, it would be non-analogous and inapplicable in rejecting the present application. Reconsideration and allowance is respectfully requested.

In view of the fact that the Dougherty reference cannot be considered prior art, it is respectfully submitted that the final rejection is improper. During the interview of March 26, 2004, Examiner Bennett acknowledged that the art was not prior art and indicated that he felt that additional searching might be in order. Accordingly, the undersigned respectfully requests that the finality of the rejection be removed and/or at least the period for response be restarted in view of the clear defect in the Office Action. However, as previously submitted, it is believed that the claims at issue are in condition for allowance and such is respectfully requested. In the event Examiner Bennett finds additional art that he wishes to discuss, the undersigned encourages Examiner Bennett to contact the undersigned at the telephone number below to discuss the nature of the art and/or any potential amendments that can be entered to avoid any subsequent rejections.

It is also submitted that none of the cited references which classify as prior art are believed to be intended for use in grading slopes using earth moving equipment, as the present invention was designed for. In general, the devices are used to measure an existing slope rather than creating a new one. Accordingly, although it is a simple structure, the adjustable pointer for setting a desired slope as a target for the grading operation is not believed to be a feature that one of ordinary skill in the art areas cited as prior art would find useful or be motivated to add. Therefore, if the Examiner identifies art

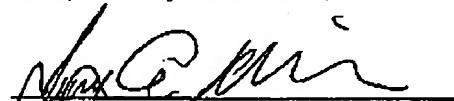
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that shows an adjustable pointer, it is respectfully submitted that he should be mindful of the need for a suggestion to combine such a pointer with devices intended for measurement of grade during earth moving construction processes in order to produce a viable combination for rejection of the current claims. Moreover, the standard for the level of ordinary skill in the art of creating a grade in an earth moving operation should also be taken carefully into consideration.

In view of this communication, all claims are believed to be in condition for allowance and such is respectfully requested at an early date. It is respectfully noted that the inventor's prior claims were drafted without benefit of representation or knowledge of claim-drafting standards. Thus, the drafting of new claims should not be considered to be a narrowing amendment.

It is respectfully requested that Examiner Bennett contact the undersigned by telephone to discuss the present response and any future search in order to advance this matter to allowance at the earliest possible time.

Respectfully submitted,



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